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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,083	07/22/2003	Keigo Ihara	275937US6CONT	5942

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EXAMINER

MARIAM, DANIEL G

ART UNIT PAPER NUMBER

2625

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,083

Applicant(s)

IHARA ET AL.

Examiner

DANIEL G. MARIAM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. In response to the Office Action mailed on September 19, 2005 applicants have submitted an amendment filed on December 19, 2005. Applicants have amended independent claim 23 by deleting the limitation “. . . has human readable information associated with said two-dimensional code directly visible thereon and . . .”, and moving this deleted limitation to a newly added dependent claim 29 (includes all of the limitation of claim 23), which depends on independent claim 23. Thus, the newly added claim 29 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 19 of U.S. Patent No. 6,650,776. The reasons set forth in the last Office Action are not repeated herein, but are entirely incorporated by reference. Additionally, claim 29, which recites the open ended transitional phrase “having” does not preclude the additional elements recited by claim 19, and whereby the elements of claim 29 are fully anticipated by patent claim 19, and anticipation is “the ultimate or epitome of obviousness” (*In re Kalm*, 154 USPQ 10 (CCPA 1967), also *In re Dailey*, 178 USPQ 293 (CCPA 1973) and *In re Pearson*, 181 USPQ 641 (CCPA 1974)).

Since claims 24-28 directly or indirectly depend on claim 29, they are also rejected on the ground of nonstatutory obviousness-type double patenting, as set forth above for claim 29.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

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Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 31 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 23 of U.S. Patent No. 6,650,776. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 31 of the present invention and claim 23 of the '776 patent have similar limitations in that claim 31 of the present invention discloses "a method of providing information pertaining to a two-dimensional code which is readable by a computer", and claim 23 of the '776 patent discloses "a storage medium for storing a program for recognizing a two-dimensional code", and claim 31 of the present invention discloses "recognizing said two-dimensional code using the reference cell as a reference", and claim 23 of the '776 patent discloses "detecting a reference cell serving as a reference in recognizing said two-dimensional code . . .", and claim 31 of the present invention discloses "locating each of the number of corner cells in a predetermined search range with respect to said reference cell", and claim 23 of the '776 patent discloses "detecting corner cells each located in a predetermined search range with respect to said reference cell detected in reference cell detecting step", and claim 31 of the present invention discloses "assigning an area of the code part having code data to said two-dimensional code", and claim 23 of the '776 patent discloses "detecting code data assigned to said two-dimensional code existing inside an area of a code part enclosed by said reference cell . . ." Thus, the claims recite common subject matter,

whereby claim 31, which recite the open ended transitional phrase “comprising”, does not exclude the additional elements recited by claim 23 of the ‘776 patent. The elements of claim 31 Are fully anticipated by patent claim 23, and anticipation is “the ultimate or epitome of obviousness” (*In re Kalm*, 154 USPQ 10 (CCPA 1967), also *In re Dailey*, 178 USPQ 293 (CCPA 1973) and *In re Pearson*, 181 USPQ 641 (CCPA 1974)).

Claim 30 which is directed to an apparatus claim is rejected the same as claim 31, and would be obvious that an apparatus is required to perform the functions recited in claim 31, since an apparatus is defined by its functionality.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 23 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang, et al. (6,000,614).

With regard to claim 30, an apparatus for providing information pertaining to a two-dimensional code which is readable by a computer (col. 3, lines 33-36; and Figure 1), said two-dimensional code having a reference cell, a number of corner cells, and a code part (See for example, Figs. 5 and 10), the apparatus comprising: a reference cell recognizer configured to recognize a reference cell serving as a reference in recognizing said two-dimensional code (See for example, col. 3, lines 38-45; and col. 14, lines 26-31); a corner cell locator configured to locate corner cells, i.e., a1-a4, b1-b4, and c1-c4 each located in a predetermined search range

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with respect to said reference cell detected by said reference cell detector (See for example, col. 14, lines 26-40); and a code data assignor configured to assign an area of a code part, having code data and enclosed by said reference cell and by said corner cells, to said two-dimensional code (See for example, col. 12, lines 28-37). Although Yang, et al does not expressly use the language recognizing the two-dimensional code using the reference cell, it would have been obvious if not inherent that functions of the apparatus (shown in Fig. 1) described in the flow chart of Figure 5 does in fact use the reference cell pattern in recognizing the two-dimensional code, among other things (See for example, item S120, in Fig. 5).

Claim 31 is rejected the same as claim 30 except claim 31 is directed to a method claim. Thus, argument analogous to that presented above for claim 30 is applicable to claim 31.

Claim 23 is rejected the same as claim 30. Thus argument similar to that presented above for claim 30 is applicable to claim 23. Claim 23 distinguishes from claim 30 only in that it recites a computer-readable medium having a two-dimensional code thereon which is readable by a computer, which also disclosed by Yang, et al. (See col. 8, lines 51-55; and Fig. 1).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL G. MARIAM whose telephone number is 571-272-7394. The examiner can normally be reached on M-F (7:00-4:30) FIRST FRIDAY OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MATTHEW BELLA can be reached on 571-272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DANIEL G MARIAM
Primary Examiner
Art Unit 2625

March 6, 2006